

REMARKS

Allowed and Allowable Claims

Claims 19-25, 31-37 and 50 have been allowed. Claim 27 has been objected to, but has been indicated as allowable if rewritten in independent form. Applicants thank the Examiner for the indication that these claims are allowed and allowable. Claim 30 depends from allowed independent claim 19, and is also submitted to be in condition for allowance.

Claim Rejections – 35 USC §102 and §103

Claims 44 and 46-49 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,015,247 to Michelson et al. (hereafter “the ‘247 patent”). Claims 26, 28-30, 38-40, 44 and 45 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,860,973 to Michelson (hereafter “the ‘973 patent”). Additionally, claims 41-43 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘973 patent in view of U.S. Patent No. 5,282,861 to Kaplan (hereafter “the ‘861 patent”).

It is well established that “an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim.” Richardson v. Suzuki Motor Co. Ltd., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989).

Rejection of Claims 44 and 46-49 as Anticipated by the ‘247 Patent

As submitted by Applicants in the Supplemental Information Disclosure Statement filed with the U.S. Patent and Trademark Office on July 1, 2005, a Request for Interference with the subject application was filed in U.S. Patent Application No. 10/740,747 to Michelson (hereafter “the ‘747 application”). The ‘747 application is in the same chain of priority as U.S. Patent Application No. 07/205,935, which issued as the ‘247 patent. Applicants note that the subject application, the ‘747 application, and the ‘247 patent are now all commonly owned.

The Request for Interference filed in the '747 application indicates that claims 44 and 46-48 of the subject application respectively correspond to claims 1-4 of the proposed count. Claim 1-4 of the proposed count in turn correspond to claims 6-9 that are currently pending in the '747 application. Claims 44 and 46-48 of the subject application are believed to be inclusive of all claims that were copied into the '747 application in an attempt to provoke an interference with the subject application.

Applicants believe that claims 6-9 pending in the '747 application (corresponding to claims 1-4 of the proposed count) have an earlier priority of invention date relative to the priority of invention date associated with claims 44 and 46-48 of the subject application. However, Applicants have amended independent claim 44 to recite that the threaded arcuate side walls of the elongated body are "tapered substantially entirely along said length". Applicants submit that independent claim 44, as amended, is no longer the same as, or for the same or substantially the same subject matter as, independent claim 6 of the '747 application. Dependent claims 46-48 correspond to dependent claims 7-9 pending in the '747 application, and have not been amended by Applicants. Since claims 44 and 46-48 of the subject application are no longer the same as, or for the same or substantially the same subject matter as, claims 6-9 pending in the '747 application, Applicants submit that the claims of the subject application do not interfere with the claims pending in the '747 application.

Claims 44 and 46-49 have been rejected under 35 U.S.C. §102(b) as being anticipated by the '247 patent. However, Applicants submit that the '247 patent does not disclose an implant having threaded arcuate side walls that are tapered substantially entirely along the length of the implant, as recited in amended independent claim 44. Applicants therefore submit that independent claim 44, as amended, is not anticipated by the '247 patent under 35 U.S.C. 102(b). Claims 46-49 depend either directly or indirectly from independent claim 44, and are therefore patentable for at least the reasons supporting the patentability of independent base claim 44. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 44 and dependent claims 46-49 as being anticipated by the '247 patent.

Rejection of Claims 26, 28-30, 38-40, 44 and 45 as Anticipated by the '973 Patent

Claims 26, 28-30, 38-40, 44 and 45 have been rejected under 35 U.S.C. §102(e) as being anticipated by the '973 patent. Additionally, claims 41-43 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the '973 patent in view of the '861 patent.

As an initial matter, as indicated above, claim 30 depends from independent claim 19, which has been allowed. Applicants therefore submit that claim 30 is allowable for at least the reasons supporting the patentability of independent claim 19. Accordingly, withdrawal of the rejection of claim 30 is respectfully requested.

Independent claim 26 has been cancelled without prejudice for possible submission in a continuing application. As indicated above, dependent claim 27, which recites that "said pair of threaded arcuate side walls are tapered along a substantial portion of said length of said elongate body", has been objected to, but has been indicated as allowable if rewritten in independent form. To that end, Applicants have rewritten dependent claim 27 in independent form. Additionally, dependent claim 28 has been amended to depend from rewritten independent claim 27. Claims 28 and 29 now depend from rewritten independent claim 27 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 27. Accordingly, Applicants respectfully request allowance of rewritten independent claim 27 and dependent claims 28 and 29.

Applicants have also amended each of the independent claims 38, 39 and 40 to recite that the arcuate side walls are "tapered along a substantial portion of said length". Applicants note that this language corresponds to the language recited in allowable independent claim 27, which also recites that the arcuate side walls are "tapered along a substantial portion of said length". The Applicants therefore submit that independent claims 38, 39 and 40, as amended, are patentable over the references of record. Accordingly, the Applicant respectfully requests withdrawal of the rejection of amended independent claims 38, 39 and 40 and allowance of the same. Additionally, claims 41-43 depend from independent claim 40 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 40.

With regard to the rejection of independent claim 44 as being anticipated by the '973 patent, as indicated above, independent claim 44 has been amended to recite that the threaded

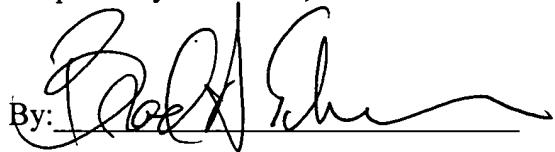
arcuate side walls of the elongated body are “tapered substantially entirely along said length”. The implant disclosed in the ‘973 patent does not include threaded arcuate side walls that are tapered substantially entirely along the length of the implant. The Applicant therefore submits that independent claim 44, as now amended, is patentable over the ‘973 patent. Accordingly, the Applicant respectfully requests withdrawal of the rejection of independent claim 44 as being anticipated by the ‘973 patent. Additionally, claims 45-49 depend from independent claim 44, and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 44.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the Applicant's application is now in condition for allowance with pending claims 19-25 and 27-50.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By: 

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